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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,799

11/18/2003

Bradley L. Todd

2000-IP-000734U1

1174

7590

09/14/2005

Robert A. Kent
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EXAMINER

SUCHFIELD, GEORGE A

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,799

Applicant(s)

TODD ET AL.

Examiner

George Suchfield

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 37-48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,6-9,11-13,16,18-21,23-25,28 and 30-33 is/are allowed.
- 6) ☒ Claim(s) 2,3,5,10,14,15,17,22,26,27,29 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/27/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-36, drawn to a method of gravel packing a well, classified in class 166, subclass 278.
 - II. Claims 37-48, drawn to a composition, classified in class 507, subclass 201.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition or product could be used in a process of fracturing a subterranean formation, drilling a well, or as a viscosity or gel breaker for any thickened or gel-based composition.
 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
 4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
 5. During a telephone conversation with Robert A. Kent on September 7, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-36.
- Affirmation of this election must be made by applicant in replying to this Office action. Claims

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37-48 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The disclosure is objected to because of the following informalities:

The specification (note Para [0016]) is deemed technically inaccurate in identifying hemicellulose as an enzyme since, in fact, hemicellulose comprises a polysaccharide. It appears that the enzyme -- hemicellulase -- was intended.

Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims "2", 3, 5, 10, 14, 15, 17, 22, 26, 27, 29 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims "2", 3, 5, 10, 14, 15, 17, 22, 26, 27, 29, and 34 are deemed indefinite in being drawn to improper Markush groupings. As noted in MPEP Section 2173.05(h), the use of the term "comprising" or "comprises" is improper in setting forth the Markush grouping.

Accordingly, in lines 1 or 2 of each of these claims, or line 4 of claim 130, the transitional phrase

“comprises” must be changed to, -- is selected from the group consisting of -- or -- is -- .

Claim “2” is further indefinite insofar as it has, instead, been numbered as claim “14”. It is deemed that claim -- 2 -- was intended, hence the claim will be so referred to throughout this Office action.

Claims 3, 15 and 27 are further indefinite in reciting the term “hemicellulose” which does not comprise an enzyme. It appears that -- hemicellulase -- was intended.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references disclose processes for gravel packing a well and/or degrading a downhole filter cake utilizing exemplary breaker agents, which may be included in the gravel packing slurry.

11. Claims 2, 3, 5, 10, 14, 15, 17, 22, 26, 27, 29 and 34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

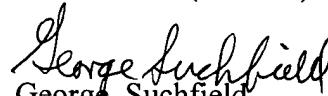
12. Claims 1, 4, 6-9, 11-13, 16, 18-21, 23-25, 28 and 30-33 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 571-272-7036. The examiner can normally be reached on M-F (5:30 - 2:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


George Suchfield
Primary Examiner
Art Unit 3676

Gs
September 9, 2005